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PATENT APPLICATION

ATTORNEY DOCKET NO. 200304427-2

ORIGINAL

IN THE

UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):	Michael J. DOUGHERTY et al.	**Confirmation No.:**	5162
Application No.:	10/674,923	**Examiner:**	J. S. Cerullo
Filing Date:	09/30/2003	**Group Art Unit:**	2112
Title:	POWERING A NOTEBOOK ACROSS A USB INTERFACE		

Mail Stop Appeal Brief-Patents
Commissioner For Patents
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TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 03/21/2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

( )	one month	$120.00
( )	two months	$450.00
( )	three months	$1020.00
( )	four months	$1590.00

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of **$500.00**. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Number of pages: 25

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Respectfully submitted,

Michael J. DOUGHERTY et al.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants:	Michael J. Dougherty et al.	§	Confirmation No.:	5162
Serial No.:	10/674,923	§	Group Art Unit:	2112
Filed:	09/30/2003	§	Examiner:	Jeremy S. Cerullo
For:	Powering A Notebook Across A USB Interface	§	Docket No.:	200304427-2

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Date: May 19, 2005

Sir:

Appellants hereby submit this Appeal Brief in connection with the above-identified application. A Notice of Appeal was filed via facsimile on March 21, 2005.

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I. APPEAL OF A NON-FINAL ACTION IS PROPER

With regard to the propriety of an appeal, 37 CFR § 41.31[1] explicitly states:

> Every applicant, any of whose claims have been twice rejected may appeal the decision of the examiner to the Board by filing a notice of appeal... .[2]

In the instant case, the Examiner issued a first Office action dated July 30, 2004, rejecting all the pending claims in some form. The Examiner also issued a second (though non-final) Office action dated January 12, 2005, maintaining the claim rejections. Thus, the claims of the pending case have been twice rejected, making appeal available under the rules.

[1] Formerly found at 37 CFR §1.191.

[2] 37 CFR §41.31.

II. REAL PARTY IN INTEREST

The real party in interest is the Hewlett-Packard Development Company (HPDC), a Texas Limited Partnership, having its principal place of business in Houston, Texas, through its merger with Compaq Computer Corporation (CCC) which owned Compaq Information Technologies Group, L.P. (CITG). The assignment from the inventors to CCC was recorded on June 30, 2000 at Reel/Frame 010911/0742. The assignment from CCC to CITG was recorded on January 16, 2002 at Reel/Frame 012394/0048. The assignment from CITG to HPDC was recorded on December 12, 2003 at Reel/Frame 014177/0428.

III. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals or interferences.

IV. STATUS OF THE CLAIMS

Originally filed claims:	1-23.
Added claims:	24-33.
Claim cancellations:	2-9, 11-19 and 21-23 (in favor of those same claims in the parent case), and claim 24.
Presently pending claims:	1, 10, 20 and 25-33.
Presently appealed claims:	1, 10, 20 and 25-33.

V. STATUS OF THE AMENDMENTS

No claims were amended after the Office action dated January 12, 2005.

VI. SUMMARY OF THE CLAIMED SUBJECT MATTER

The various embodiments of the invention are directed to powering a notebook computer across a USB interface.[3] At least some of the illustrative embodiments may be a computer system comprising a device,[4] and a laptop computer coupled to said device by way of a communication bus operated under a communication protocol[5] (the communication bus comprising communication lines and power lines.)[6] The device determines if the laptop computer is capable of being powered across the power lines of the communication bus by communication with the laptop across the power lines of said communication bus.[7]

Other illustrative embodiments may be a method of operating a computer system comprising a laptop computer adapted to dock to a docking station by way of a USB interface, the method comprising powering said laptop computer from said docking station across said USB interface with a voltage in excess of five volts.[8]

Yet still other illustrative embodiments may be a docking station[9] for mating with a laptop computer[10] comprising a Universal Serial Bus (USB) interface having data signal lines and power rails that couple to the laptop computer,[11] and a docking logic that provides power to said laptop over the power rails of the USB interface at a voltage of greater than five volts.[12]

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[3] Specification Title.

[4] *See, e.g.*, Specification Page 5, lines 20-21; Figures 1 and 2. Hereinafter, citations to the Appellants' specification take the form ([page(s)], lines [lines on the page]). Thus, the current citation in the shorthand notation has the form (Page 5, lines 20-21).

[5] (Page 8, lines 15-20); Figure 2.

[6] (Page 8, lines 5-14); Figures 1 and 2.

[7] (Page 8, lines 12-14).

[8] (Page 12, lines 3-7).

[9] (Page 5, lines 20-21).

[10] (Page 5, lines 20-21).

[11] (Page 8, lines 10-14).

[12] (Page 12, lines 3-7).

Other illustrative embodiments may be a computer system comprising a device having power available therein,[13] a laptop computer coupled to said device by way of a communication bus[14] that, in a first mode, operates under the Universal Serial Bus (USB) protocol,[15] and in a second mode of operation said laptop computer powered by said device across the power lines of said communication bus.[16]

Yet still other illustrative embodiments may be a method comprising powering downstream devices by power rails of a bus interface of a laptop computer (the bus interface operated in compliance with the Universal Serial Bus (USB) protocol, and the powering in a first mode of operation),[17] and accepting (in a second mode of operation) power by the laptop computer on the power rails of the bus interface.[18]

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[13] *See, e.g.,* (Page 5, lines 20-21).

[14] (Page 8, lines 15-20); Figure 2.

[15] (Page 8, line 19 – Page 9, line 2).

[16] (Page 12, lines 11-13).

[17] (Page 8, line 19 – Page 9, line 2).

[18] (Page 12, lines 11-13).

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims[19] 1, 25-26 and 30-31 are unpatentable over Bard (U.S. Pat. No. 6,530,026).

Whether claims 10, 20, 28-29 and 32-33 are unpatentable over Bard in view of Atkinson (U.S. Pat. No. 5,884,049).

Whether claims 10, 28-29 are unpatentable under 35 USC § 112, first and second paragraphs.

[19] The Office action dated January 12, 2005 does not make a specific rejection of claim 1, but given that Atkinson is relied upon for a voltage teaching (which is not recited in claim 1), it is presumed that the rejection of claim 1 is same as that of claims 25-26 and 30-31.

VIII. ARGUMENT

A. Claims 10 and 28-29 Are Not Unpatentable Under Section 112.

Claims 10 and 28-29 stand rejected under Section 112, first and second paragraphs. Claim 10 is illustrative of this grouping of claims. This grouping is for purposes of this appeal only, and should not be construed to mean the patentability of any of the claims may be determined, in later actions before a court, based on the grouping. Rather, the presumption of 35 U.S.C. § 282 shall apply to each claim individually.

The Office action dated July 30, 2004 rejected this grouping of claims as being based on a disclosure which is allegedly not enabling, and for alleged indefiniteness problems.[20] The Office action dated January 12, 2005 maintains the rejections under 35 USC §112.[21] Each of these rejections will be addressed in turn.

1. The Claims Are Based On An Enabling Disclosure.

The Office action dated July 30, 2004, and likewise the Office action dated January 12, 2005 based on maintaining the previous rejections, rejects this grouping of claims[22] under Section 112, first paragraph, stating, "The modification of USB interfaces critical or essential to the practice the invention ... is not enabled by the disclosure. ... By claiming powering of the laptop by a device over USB power lines, the invention is not enabled because it is not within the scope of the USB specification to do so."[23]

The Manual for Patent Examining Procedures (MPEP) defines the test for enablement under Section 112 as follows:

> [W]hether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. ... [E]ven though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled

[20] Office action dated July 30, 2004, number paragraphs 2 and 4.

[21] Office action dated January 12, 2005, numbered paragraph 2.

[22] And others, but some of the rejections were dropped in the latest Office action.

[23] Office action dated July 30, 2004, number paragraph 2.

> so that any person skilled in the art can make and use the invention without undue experimentation.[24]

Appellants' specification provides a docking logic 134 in the laptop that, in some modes, operates under an illustrative USB protocol.

> Under standard USB protocol, the laptop computer **100** provides power to USB devices downstream of the laptop computer **100**. **Thus, in normal operation, the USB protocol voltage control unit 140 receives a five volt input signal 142 which it couples to the positive power rail 144 of the power conductors 138.** Downstream USB devices may draw current through the positive power rail **144**. If a user of the laptop computer **100** plugs in, for example, a USB mouse into the USB connector **136**, that mouse under USB protocol may draw power across the power conductors **138** for its operational use.[25]

In other modes, however, the laptop turns off the power provided on the power rails, and instead receives power on those power rails, such as from a docking station.[26] In order to accomplish this role reversal for the illustrative USB power lines, the specification describes hardware (both in the laptop and the docking station and including part numbers) and related methods to test for compatibility of the laptop to receive power prior to assertion of power.[27]

While in some modes the various embodiments may part with the illustrative USB protocol, illustrative hardware and methods to depart from the standard are provided and enabled by the disclosure. For this reason alone the rejection of this grouping of claims under Section 112 should be reversed.

Further, the assertion of the Office action dated July 30, 2004 and January 12, 2005 seem to imply that the enabling disclosure must appear in the claims.

> Although the applicant does disclose that his invention contains circuitry to allow a laptop to accept power over the power rails of a

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[24] MPEP 2164.01 (8th Ed., Rev. 2, May 2004), Page 2100-185.

[25] (Page 8, line 19 – Page 9, line 2) (emphasis added); Figure 2.

[26] (Page 9, line 19 – Page 10, line 6).

[27] (Page 8, line 15 – Page 12, line 13); (Page 11, line 5 – Page 12, line 2).

> modified USB interface, **such modifications are not claims [sic] in Claim 10, nor either of its dependents**... .[28]

Appellants respectfully submit that the Office action applies an incorrect test for enablement. As discussed above, the test is not whether the claims contain the enabling disclosure, but rather whether the "disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention." For the reasons discussed above, Appellants submit to the Board that the disclosure enables this illustrative grouping of claims. For this additional reason the rejection of this grouping of claims under Section 112 should be reversed.

2. Claims 10 and 28-29 Are Not Indefinite For Parting With The USB Protocol.

The Office action dated July 30, 2004, and likewise the Office action dated January 12, 2005 based on maintaining the previous rejections, rejects this grouping of claims under Section 112, second paragraph, stating:

> The applicant claims the powering of a laptop computer by a device over USB power lines. The USB specification states that: "No device shall apply (source) current on VBUS at its upstream facing port at any time. From VBUS on its upstream port, a device may only draw (sink)current." ... The claim is therefore indefinite because the use of the term USB is different from the accepted standard use.[29]

Thus, the rejection seems to imply that because the direction of power flow is claimed in some modes opposite of that defined in the USB specification, that the claims are allegedly indefinite.

The specification clearly discloses a dual purpose interface that, in some modes may operate, *e.g.*, as an USB interface[30], and in other modes departs with the illustrative USB specification and accepts power to power the laptop.[31] Appellants respectfully submit to the Board that the mere departure from a known

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[28] Office action dated January 12, 2005, numbered paragraph 2 (emphasis added).

[29] Office action dated July 30, 2004, numbered paragraph 4.

[30] (Page 8, line 19 – Page 9, line 2); Figure 2.

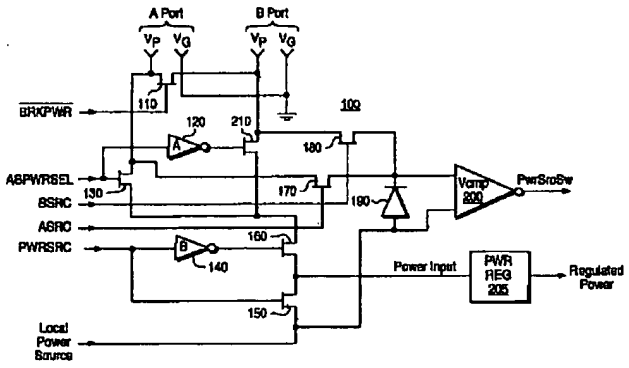
[31] (Page 9, line 19–Page 10, line 6).

standard does not result in statutory indefiniteness, that these Section 112, second paragraph, rejections have no basis in law or fact, and thus that the rejections be overturned.

B. Art-Based Rejections of Claim 1.

Claim 1 stands rejected as allegedly obvious over Bard.

Bard is directed to a circuit and method for power distribution management.[32] Bard's Figure 1, reproduced immediately below, is illustrative of a circuit placed within each "node" of a Bard system to control power flow into, out of, or through the node.[33]



Starting at the top of the figure and working clockwise, the "A Port" and "B Port" are power ports, through which power may either be delivered or received.[34] The "PwrSrcSw" is a signal that becomes asserted when a voltage on one of the power ports becomes greater than voltage of a local power source.[35] The "Regulated Power" is regulated power of the "Power Input," which power input may come from any of the power ports or the "Local Power Source" (lower left corner of the figure).[36]

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[32] Bard Title.

[33] Bard Col. 4, lines 8-10.

[34] Bard Col. 3, lines 28-29.

[35] Bard Col. 3, lines 67 – Col. 4, line 3.

[36] Bard Col. 3, lines 62-67.

The circuit of Bard's Figure 1 also has a plurality of signals along the left side that control power flow within the circuit. In particular, the "PWRSRC" signal, when asserted, configures the device 100 to couple the local power source to the power regulator 205, and when not asserted configures the device 100 to couple power from one of the power ports.[37] When the "ASRC" signal is asserted, power from the local power source is delivered out of the A Port.[38] When the "BSRC" signal is asserted, power from the local power source is delivered out of the B Port.[39] When power is delivered to the node containing the illustrative device 100 of Bard's Figure 1, the "ABPWRSEL" signal selects from which power port that power is taken.[40] Finally, the "BRKPWR" signal controls whether the flow of power from power port to power port is allowed.[41] All of these control signals are derived externally of the respective node, such as by software on a PC.[42] Thus, signaling for purposes of power flow control takes place over the plurality of signals (along the left side of the figure), and these signals are different than the lines that carry the power (V_p, V_g).

Illustrative claim 1, by contrast, specifically requires, "a laptop computer coupled to said device by way of a communication bus operated under a communication protocol, the communication bus comprising communication lines and power lines; wherein the device determines if the laptop computer is capable of being powered across the power lines of the communication bus **by communication with the laptop across the power lines of said communication bus**." Appellants respectfully submit to the Board that Bard does not teach or fairly suggest the limitations of illustrative claim 1. As discussed above, Bard has separate power and control signals, and thus does not teach or

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[37] Bard Col. 3, lines 50-55.

[38] Bard Col. 3, lines 48-50.

[39] Bard Col. 3, lines 47-48.

[40] Bard Col. 3, lines 33-39.

[41] Bard Col. 4, lines 13-19 (such as when the node containing the device 100 is self powered, but where nodes downstream of the instant node are being provided power from upstream nodes).

[42] Bard Col. 3, lines 3-18.

suggest determining "if the laptop computer is capable of being powered across the power lines of the communication bus by communication with the laptop across the power lines of said communication bus." For this reason alone the rejections of this grouping should be reversed and the claims set for issue.

The Office action dated January 12, 2005 cites Bard Col. 4, line 61 – Col. 5, line 18 for an alleged teaching of communication over the power lines, but the citation, and Bard in general, falls woefully short. The cited location discusses a feature where a device 100 of Bard in a node may automatically switch from the Local Power Source to power from a power port if the power port has higher voltage.[43] The Office action dated January 12, 2005 asserts that the increased voltage is a "communication" which causes the switch.[44] Illustrative claim 1 requires, however, that "the device determines if the **laptop computer is capable of being powered** across the power lines of the communication bus by communication with the laptop across the power lines of said communication bus." If the increased voltage from the upstream node is considered a communication (which Appellants do not admit is a proper interpretation of a mere power line voltage increase), the only information that could be gleaned from the "communication" is that the upstream node **is capable of providing power**. Thus, if the upstream node is the claimed laptop, no information regarding whether the laptop can accept power can be gleaned from an increased voltage on a power bus. Even if the voltage level drops, Bard teaches only that the current node should switch back to its Local Power Source, not that the upstream node is capable of being powered across those power lines. For this additional reason, the rejections of this grouping of claims should be reversed and the claims set for issue.

Based on the foregoing, Appellants respectfully submit that the rejections of the claims in this first grouping be reversed, and the claims set for issue.

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[43] Bard Col. 4, line 61 – Col. 5, line 18.

[44] Office action dated January 12, 2005, numbered paragraph 1.

C. Art-Based Rejections of Claims 25-26 and 30-31.

Claims 25-26 and 30-31 stand rejected as allegedly obvious over Bard. Claim 26 is illustrative of this grouping. This grouping is for purposes of this appeal only, and should not be construed to mean the patentability of any of the claims may be determined, in later actions before a court, based on the grouping. Rather, the presumption of 35 U.S.C. § 282 shall apply to each claim individually.

Illustrative claim 26 requires, "a device having power available therein; a laptop computer coupled to said device by way of a communication bus that, in a first mode, operates under the Universal Serial Bus (USB) protocol; and in a second mode of operation said laptop computer powered by said device across the power lines of said communication bus." The Office action dated January 12, 2005 asserts that, in view of Bard, one of ordinary skill in the art would know to part with the USB standard and supply power to the laptop over the power rails.[45] The assertion of the Office action is apparently based on Bard's alleged teaching that, "One problem that has not been addressed in connection with such high performance serial buses ... is how power is to be managed and allocated... ."[46] In the case of USB, however, the Examiner has admitted as a matter of law that allocation and management has been addressed:

> The USB specification states that: "No device shall apply (source) current on VBUS at its upstream facing port at any time. From VBUS on its upstream port, a device may only draw (sink) current."[47]

Appellants therefore respectfully submit that Bard does not teach or suggest a departure from the USB standard to have a first mode operation that operates under the USB protocol, and a second mode of operation where a laptop is powered by power lines that, under the USB protocol, should only source power. For this additional reason, the rejection of this grouping of claims should be reversed and the claims set for issue.

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[45] Office action dated January 12, 2005, numbered paragraph 5.

[46] Bard Col. 2, lines 5-8.

[47] Office action dated July 30, 2004, numbered paragraph 4.

Based on the foregoing, Appellants respectfully submit that the rejections of the claims in this first grouping be reversed, and the claims set for issue.

D. Art-Based Rejections of Claims 10, 20, 28-29 and 32-33.

Claims 10, 20, 28-29 and 32-33 stand rejected as allegedly obvious over Bard in view of Atkinson. Claim 20 is illustrative of this grouping of claims. This grouping is for purposes of this appeal only, and should not be construed to mean the patentability of any of the claims may be determined, in later actions before a court, based on the grouping. Rather, the presumption of 35 U.S.C. § 282 shall apply to each claim individually.

Illustrative claim 20 specifically recites a docking station comprising "a Universal Serial Bus (USB) interface having data signal lines and power rails that couple to the laptop computer; and a docking logic that provides power to said laptop over the power rails of the USB interface at a voltage of greater than five volts." Thus, not only does the docking station of illustrative claim 20 part with the USB protocol and provide power to an attached laptop, but the claim also requires that voltage on the power rails exceed the USB protocol. Appellants respectfully submit that Bard does not teach or suggest a departure from USB protocol, and even if the teachings of Atkinson are precisely as the Office action suggests (which Appellants do not admit), and for the reasons discussed in the immediately preceding section, Bard and Atkinson still fail to teach "a docking logic that provides power to said laptop over the power rails of the USB interface... ." For this reason alone, the rejection of this grouping of claims should be overturned and the claims set for issue.

Even if it is hypothetically assumed that Bard teaches a departure from the USB protocol **regarding directions of power flow** (which Appellants do not admit), Bard does not teach or suggest a departure from USB protocol **regarding supplied voltage**. Thus, even if the teachings of Atkinson are precisely as the Office action suggests (which Appellants do not admit), Bard and Atkinson still fail to teach "a docking logic that provides power to said laptop at a voltage of greater than five volts" in direct contravention of the USB protocol. For this additional

reason, the rejection of this grouping of claims should be overturned and the claims set for issue.

Based on the foregoing, Appellants respectfully submit that the rejections of the claims in this second grouping be reversed, and the grouping set for issue.

IX. CONCLUSION

For the reasons stated above, Appellants respectfully submit that the Examiner erred in rejecting all pending claims. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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X. CLAIMS APPENDIX

1. (Previously presented) A computer system, comprising:

a device; and

a laptop computer coupled to said device by way of a communication bus operated under a communication protocol, the communication bus comprising communication lines and power lines;

wherein the device determines if the laptop computer is capable of being powered across the power lines of the communication bus by communication with the laptop across the power lines of said communication bus.

2.-9. (Canceled).

10. (Previously presented) In a computer system comprising a laptop computer adapted to dock to a docking station by way of a USB interface, a method of operating said computer system comprising:

powering said laptop computer from said docking station across said USB interface with a voltage in excess of five volts.

11.-19. (Canceled).

20. (Previously presented) A docking station for mating with a laptop computer comprising:

a Universal Serial Bus (USB) interface having data signal lines and power rails that couple to the laptop computer; and

a docking logic that provides power to said laptop over the power rails of the USB interface at a voltage of greater than five volts.

21.-24. (Canceled).

25. (Previously presented) The computer system as defined in claim 26 wherein the device further comprises a docking station.

26. (Previously presented) A computer system, comprising:
a device having power available therein;
a laptop computer coupled to said device by way of a communication bus that, in a first mode, operates under the Universal Serial Bus (USB) protocol; and
in a second mode of operation said laptop computer powered by said device across the power lines of said communication bus.

27. (Previously presented) The computer system of claim 1 wherein the laptop computer is capable of providing power to external devices across the communication bus when the laptop is not coupled to the device.

28. (Previously presented) The method of claim 10 further comprising powering the laptop computer from the docking station across the USB interface with substantially 18 volts.

29. (Previously presented) The method of claim 10 further comprising shutting off power to the communication bus when a laptop computer is detached from the docking station.

30. (Previously presented) A method comprising:
powering downstream devices by power rails of a bus interface of a laptop computer, the bus interface operated in compliance with the Universal Serial Bus (USB) protocol, and the powering in a first mode of operation; and
accepting, in a second mode of operation, power by the laptop computer on the power rails of the bus interface.

31. (Previously presented) The method as defined in claim 30 further comprising accepting power from a docking station on the power rails of the bus interface.

32. (Previously presented) The method as defined in claim 30 further comprising accepting power at a voltage in excess of five volts.

33. (Previously presented) The method as defined in claim 32 further comprising accepting power at a voltage level of substantially 18 volts.